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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,120	02/28/2002	Gerald Steiner	GEST.001A	3606
7663	7590	02/24/2005	EXAMINER	
STETINA BRUNDA GARRED & BRUCKER			NGUYEN, KIMBERLY D	
75 ENTERPRISE, SUITE 250				
ALISO VIEJO, CA 92656			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CT

Office Action Summary	Application No. 10/090,120	Applicant(s) STEINER, GERALD	
	Examiner Kimberly D. Nguyen	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) 7-12 and 18-20 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-6 and 13-17 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Acknowledgement is made of Response to Restriction Requirement filed December 6, 2004, which applicant provisionally elects to prosecute claims 1-6 and 13-17 (Group I, drawn to a method and apparatus for mailing a package from a merchant to a customer, the package comprising: a surface having a barcode thereon, wherein the barcode identifies the customer) without traverse. Claims 7-12 and 18-20 are withdrawn, without prejudice, from further consideration by applicant, 37CFR 1.142(b), as being drawn to non-elected claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 13, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser et al. (US 6,536,659; hereinafter “Hauser”).

Re claims 1, 3, and 17: Hauser teaches a package (e.g., goods, merchandise, etc) for mailing items from a merchant to a customer (“The return label can be provided with the merchandise when purchased by the customer...” (col. 2, lines 19-20)), the package comprising at least one surface, the surface having barcode thereon; wherein the barcode identifies the customer (“This label includes a scannable bar code identifying the merchant and the customer” (abstract)) (col. 2, lines 9-67; col. 3, line 43 through col. 6, line 49).

Re claim 2: Hauser teaches "...this label includes a scannable bar code identifying the merchant and the customer ... the scannable bar code is scanned so that the merchandise can be sorted ... and the customer is electronically credited for the return of the merchandise..." (abstract; col. 2, lines 13-15, lines 19-20, and lines 53-55), which serves as the bar code includes a complete order (i.e., the merchandise purchased by the customer) and return history (i.e., the returned merchandise is recorded and credited to the customer's account).

Re claim 4: Hauser teaches scanning the bar code enables the merchant to identify items in which the customer is interested ("The data identify the merchant and the merchandise purchased by a customer" (col. 2, lines 19-20)).

Re claims 5-6: Hauser teaches a method of tracking an order and return history of a customer, the method including the steps of:

providing a package including a bar code (the return label having a scannable bar code thereon) that identifies the customer (abstract; col. 2, lines 10-27; col. 4, lines 30-35);

receiving the package from the customer, the package containing returned items (col. 2, lines 10-27; col. 4, lines 36-40);

scanning the bar code to identify the customer (abstract, lines 8-9);

inputting the returned items into an inventory database (col. 2, lines 28-38; col. 5, lines 6-20); and

updating the customer's order and return history (col. 2, lines 49-67; col. 5, lines 21-44).

Re claim 13: Hauser teaches the bar code includes information on orders (i.e., the purchased merchandise) and returns (i.e., the returned merchandise) for the customer.

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Re claim 16: Hauser teaches information on at least one item in which the customer is interested is included in the package (container (col. 4, lines 36-48)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of Savino et al. (US 6,015,167; hereinafter "Savino"). The teachings of Hauser have been discussed above.

Hauser fails to specifically teach the customer is identified by name/address.

Savino teaches a system and method for employing a single bar code for coordinating shipping, wherein the customer is identified by customer name and address (fig. 5; col. 3, line 62 through col. 4, line 35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the identifying customer by name/address as taught by Savino to the teachings of Hauser in order positively identify the customer's name and residence.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN

February 21, 2005



DIANE I. LEE
PRIMARY EXAMINER